



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/066,584	02/06/2002	Yutaka Kudo	62807-031	5797
7590	11/17/2004		EXAMINER	
McDermott, Will & Emery 600, 13th Street, N.W. Washington, DC 20005-3096			VAUGHN, GREGORY J	
			ART UNIT	PAPER NUMBER
			2178	
DATE MAILED: 11/17/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/066,584	KUDO ET AL.	
	Examiner	Art Unit	
	Gregory J. Vaughn	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
 THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 06 February 2002.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-13 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 06 February 2002 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2/6/02
- 4) Interview Summary (PTO-413) Paper No(s) _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

DETAILED ACTION

Application History

1. This action is responsive to the application filing, Application filed on 2/6/2002.
2. Claims 1-13 are pending in the case, claims 1, 2, 3, 5, 6, 7, 8, 9, 11, 12 and 13 are independent claims.

Priority

3. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d) to Japanese application 2001-349564 (filed 11/15/2001). The certified copy of this application has been filed in the current application.

Drawings

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description:
 - “605-607” on page 12, line 19; .
 - “605” on page 12, line 20; page 16, line 25; page 18, line 12.
 - “606” on page 12, line 20; page 16, line 25; page 18, line 12.
 - “607” on page 13, line 6; page 17, line 17; page 18, line 12.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

5. The disclosure is objected to because of the following informalities:

- The disclosure recites "*In this case one paragraph is composed of a header character string (611, 621)*" (page 12, lines 24-25).
The reference to Figure 6 is directed toward two paragraphs.
- The disclosure recites "*For example, for "ER model" 304 in FIG. 3*" (page 22, lines 25-26). Reference sign 304 in Figure 3 is directed toward "*Physical Design*".
- The disclosure recites those reference signs listed in paragraph 4 above, which are not shown in the drawings.

Appropriate correction is required.

6. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title."

8. Claims 7-9 and 11-12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

9. The claimed invention is so abstract and sweeping as to cover the method if practiced by a human operator assisted only by pencil and paper. The claims 7-9 and 11-12 do not include a particular machine or apparatus, and no machine-implemented steps are recited. Every step is capable of performance by the human mind. A method of this sort, traditionally called a "mental process", is not patentable subject matter.

"Phenomena of nature, though just discovered, "*mental processes*", abstract intellectual concepts are not patentable as they are the basic tools of scientific and technological work." (Emphasis added). *Gottschalk v. Benson*, 175 U.S.P.Q. 673, 675 (U.S.S.C. 1972). See also, *In re Prater and Wei*, 159 U.S.P.Q. 583 (1968), *rehearing*, 162 U.S.P.Q 571 (1969).

Claim Rejections - 35 USC § 112

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

"The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention."
11. Claims 4 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
12. Claim 4 recites the limitation "*said pending issue management system*" in the second and third limitations to the claim. There is insufficient antecedent basis for this limitation in the claim.
13. Claim 10 recites the limitation "*said pending issue management system*" in the second and third limitations to the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

"(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made."

15. Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robins, US Publication 2002/0165742, filed 3/21/2000, published 11/7/2002 in view of Courter et al. "Microsoft Office 2000 Professional Edition" published 1999 (hereinafter Courter).

16. **Regarding independent claim 1**, Robins discloses a project information linking method. Robins recites: "*The method steps, which the system is configured to carry out, include enumerating features to be included in the product, enumerating tasks, task milestones, task milestone completions, task approvals and feature approvals, and linking them to the features*" (page 1 paragraph 9). Robins discloses a review report management system that stores review report items. Robins recites: "*The invention provides a method and system for monitoring and managing the product release process using an overall visibility mechanism that positively links features and tasks using, for example, the integrity constraints and keys of the relational database*

paradigm or, equivalently, the entity-relationship model of other database paradigms" (page 2, paragraph 30).

Robins discloses a work item management system with hierarchically defined work items in Figure 4 at reference signs 41, 42, 43 45 and 47 (shown as "Feature", "MRO", "Task", "Test Plan" and "Documentation"). Robins further discloses displaying the progress of the work items in Figure 7 at reference sign 101 (shown as "COMP %").

Robins discloses reading a document name from work item list in Figure 10 at reference sign 169 (shown as "Document Description – Title"). Robins discloses obtaining pending issues related to the document name. Robins recites: "*Managers in technical publications use the Tech Documents List view shown in FIG. 10 to enter and track information relating to documents being developed to describe product features*" (page 4, paragraph 103).

Robins discloses a project information linking method, a review report management system that stores review report items, a work item management system with hierarchically defined work items, displaying the progress of the work items, reading a document name from work item list and obtaining pending issues related to the document name. Robins fails to disclose outputting a template of a report with pending issues as headers of the report content. Courter teaches the outputting of reports of data from systems. Courter discloses in "*Chapter 32 – Creating Reports*" (pages 783-799) the outputting of a report template with headers (see Figure 32.6, page

789) where the headers are data derived from the system data (shown as “Category Name” in Figure 32.6).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the system reporting teachings of Counter to produce reports for the project management systems of Robins in order to “*show all or only some of the data related to a record, and it can be based on either a table or a query*” (Counter, page 784, first paragraph).

17. **Regarding independent claim 2,** Robins discloses a project information linking method. Robins recites: “*The method steps, which the system is configured to carry out, include enumerating features to be included in the product, enumerating tasks, task milestones, task milestone completions, task approvals and feature approvals, and linking them to the features*” (page 1 paragraph 9). Robins discloses a pending issues management system that stores pending issue data. Robins recites: “*Engineering managers can use the Engineer Task List view shown in FIG. 7 to enter and track information relating to tasks being completed to implement features. Engineering tasks may include concept design, detailed design, design verification, prototyping, debugging, limited testing, and, in the case of hardware, prototyping, and trial or pilot production*” (page 3, paragraph 57).

Robins discloses a work item management system with hierarchically defined work items in Figure 4 at reference signs 41, 42, 43 45 and 47 (shown as “Feature”, “MRO”, “Task”, “Test Plan” and “Documentation”).

Robins further discloses displaying the progress of the work items in Figure 7 at reference sign 101 (shown as "COMP %").

Robins discloses reading a document name from work item list in Figure 10 at reference sign 169 (shown as "*Document Description – Title*"). Robins discloses obtaining pending issues related to the document name. Robins recites: "*Managers in technical publications use the Tech Documents List view shown in FIG. 10 to enter and track information relating to documents being developed to describe product features*" (page 4, paragraph 103).

Robins discloses a project information linking method, a review report management system that stores review report items, a work item management system with hierarchically defined work items, displaying the progress of the work items, reading a document name from work item list and obtaining pending issues related to the document name. Robins fails to disclose outputting a template of a report with which contains paragraphs of extracted pending issue data. Courter teaches the outputting of reports of data from systems. Courter discloses in "*Chapter 32 – Creating Reports*" (pages 783-799) the outputting of a report template with paragraphs (see Figure 32.6) where the paragraphs are data derived from the system data (shown as "*Product Name*" in Figure 32.6).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the system reporting teachings of Courter to produce reports for the project management systems of Robins in

order to "show all or only some of the data related to a record, and it can be based on either a table or a query" (Courter, page 784, first paragraph).

18. **Regarding independent claim 3**, the claim contains substantially the same subject matter as claims 1 and 2 combined, and is rejected using the same rationale.
19. **Regarding dependent claim 4**, the claim is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, as described above.
20. **Regarding independent claim 5**, Robins discloses a project information linking method as described above. Robins also discloses a review report management system and a work item management system as described above. Robins disclose calculating a countermeasure ratio of a pending issue in Figure 7 at reference sign 101 (shown as "Comp. %"). Robins discloses registering the ratio with said work item management system. Robins recites: "*Engineering managers enter engineering tasks into the Engineering Task List*" (page 3, paragraph 57).
21. **Regarding independent claim 6**, Robins discloses a project information linking method as described above. Robins also discloses a review report management system and a work item management system as described above. Robins disclose calculating a discussion ratio of a review item in

Figure 8 at reference sign 116 (shown as "Comp. %"). Robins discloses registering the ratio with said work item management system. Robins recites: "*Engineering managers enter engineering tasks into the Engineering Task List*" (page 3, paragraph 57).

22. **Regarding independent claim 7**, the claim is directed toward a system for the method of claim 1, and is rejected using the same rationale.
23. **Regarding independent claim 8**, the claim is directed toward a system for the method of claim 2, and is rejected using the same rationale.
24. **Regarding independent claim 9**, the claim is directed toward a system for the method of claim 3, and is rejected using the same rationale.
25. **Regarding dependent claim 10**, the claim is directed toward a system for the method of claim 4, and is rejected using the same rationale.
26. **Regarding independent claim 11**, the claim is directed toward a system for the method of claim 5, and is rejected using the same rationale.
27. **Regarding independent claim 12**, the claim is directed toward a system for the method of claim 6, and is rejected using the same rationale.
28. **Regarding independent claim 13**, the claim is directed toward a recording medium for the method of claim 1, and is rejected using the same rationale.

Conclusion

29. The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

<u>Patent/Publication</u>	<u>Date</u>	<u>Inventor</u>
• US-6,240,395	05-2001	Kumashiro, Jyunji
• US-6,247,032	06-2001	Bernardo et al.
• US-6,263,379	07-2001	Atkinson et al.
• US-6,282,514	08-2001	Kumashiro, Jyunji
• US-6,308,164	10-2001	Nummelin et al.
• US-6,308,187	10-2001	DeStefano, George Francis
• US-6,308,188	10-2001	Bernardo et al.
• US-6,526,388	02-2003	Sakaguchi et al.
• US-6,581,040	06-2003	Wright et al.
• US-6,626,953	09-2003	Johndrew et al.
• US-6,640,244	10-2003	Bowman-Amuah, Michel K.
• US-6,671,693	12-2003	Marpe et al.
• US-6,766,319	07-2004	Might, Robert J.
• US-6,795,071	09-2004	Tracey et al.
• US-2003/0046345	03-2003	Wada et al.
• US-2003/0061330	03-2003	Frisco et al.
• US-2003/0066030	04-2003	Curns et al.
• US-2003/0188290	10-2003	Corral, David Perez

30. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Vaughn whose telephone number is (571) 272-4131. The examiner can normally be reached Monday to Friday from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S. Hong can be reached at (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is (571) 272-2100.

Art Unit: 2178

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



STEPHEN S. HONG
PRIMARY EXAMINER

Gregory J. Vaughn
November 3, 2004